

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Kiyotaka Nakano et al.
Patent No. : 7,919,086
Issue Date : April 5, 2011
Serial No. : 10/583,795
Filed : June 21, 2006
Title : ANTI-GLYPLICAN 3 ANTIBODY

Art Unit : 1643
Examiner : Lynn Anne Bristol
Conf. No. : 4422

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION UNDER 37 C.F.R. § 1.181(a)(3)
TO INVOKE THE SUPERVISORY AUTHORITY OF THE DIRECTOR

Patentee hereby petitions under 37 C.F.R. § 1.181(a)(3) to invoke the supervisory authority of the Director in response to a Decision on Application for Patent Term Adjustment (“the Decision”) mailed by the Office of Petitions on September 23, 2011.

The Decision maintained that the present patent is entitled to 183 days of Patent Term Adjustment (PTA) and denied applicants’ request to defer a decision on the petition pending the final resolution in Abbott Biotherapeutics Corp. v. Kappos, 1:2010cv01853 (D.D.C. filed October 29, 2010). Patentee requests that the Director review the Decision as well as the remarks presented herein and modify the PTA calculation to 321 days or, in the alternative, to hold the decision in abeyance pending the final resolution in Abbott Biotherapeutics Corp. v. Kappos.

I. The Office Incorrectly Excluded a Period of Time from B Delay that Does Not Correspond to Time Consumed by Continued Examination

The Decision stated that the patent is entitled to 183 days of PTA. Patentees maintain that the patent is entitled to 321 days of PTA, for the reasons provided below.

“A Delays” are defined as delays by the Office under 35 U.S.C. § 154(b)(1)(A), which guarantees prompt response by the Office. It is Patentees’ understanding that there is no dispute that there was one period of A Delay (August 22, 2007, to December 18, 2007) for a total of 119 days.

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“B Delays” are defined as delays by the Office under 35 U.S.C. § 154(b)(1)(B), which guarantees no more than three year application pendency. Patentees submit that B Delay accumulated for a total of 653 days, beginning on June 22, 2009 (the day after the date that is three years after the date that the national stage commenced), and ending April 5, 2011 (the date the patent was issued). The Office has excluded from B Delay the number of days corresponding to the period beginning on August 13, 2010 (the date on which a Request for Continued Examination was filed), and ending on April 5, 2011 (the date the patent was issued). However, this entire period should not be excluded from B Delay because it does not correspond in its entirety to continued examination. The Notice of Allowance Action mailed on November 19, 2010, closed examination of the application on that date. Section 154(b)(1)(B)(i) of Title 35 excludes from B Delay “time consumed by continued examination of the application.” The statute does not provide for exclusion from B Delay of time from the mailing of a Notice of Allowance until issuance (a period during which continued examination did not occur). Thus, no continued examination took place during the 138 day period from November 19, 2010 (the mailing date of the Notice of Allowance), until April 5, 2011 (the date the patent was issued). Accordingly, 138 days of B Delay should have been included in addition to the 417 days accorded by the Director, for a total B Delay of 555 days. Patentees respectfully submit that the Office’s calculation of “B Delay” is incorrect and that the correct PTO Delay for issuance beyond three years from filing is 555 days.

The legal issue presented in the preceding paragraph is currently the subject of a civil action against the Office in Abbott Biotherapeutics Corp. v. Kappos, 1:2010cv01853 (D.D.C. filed October 29, 2010). The plaintiff in Abbott Biotherapeutics Corp. v. Kappos has argued that the Office improperly calculated the length of the statutory delay period defined by 35 USC 154(b)(1)(B) by subtracting from the delay period the number of days from the mailing of a Notice of Allowance until issuance (a period during which continued examination did not occur). In the event that the Office is unwilling to increase PTA for the present patent in the manner requested herein, Patentees request that a final decision on this petition be held in abeyance pending the final resolution in Abbott Biotherapeutics Corp. v. Kappos. A decision in

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Abbott Biotherapeutics Corp. v. Kappos will likely settle the legal issue that is central to the present petition.

II. Conclusion and Statement of Patent Term Adjustment

For the reasons detailed herein, the Office erred in the calculation of patent term adjustment by excluding from B delay the time from the mailing of a Notice of Allowance to the issuance of the patent, when continued examination was closed. Accordingly, 138 days of B delay for period from November 19, 2010 (the mailing date of the Notice of Allowance), until April 5, 2011 (the date the patent was issued) should have been included in addition to the 417 days accorded by the Director, for a total B Delay of 555 days.

Patentee requests reconsideration of the patent term adjustment in the following manner:

- 1) Total Office Delay should be calculated as 674 days (i.e., the sum of 119 days of A Delay and 555 days of "B Delay" minus 0 days of overlap);
- 2) Total Applicant Delay is 353 days; and
- 3) Total Patent Term Adjustment should be calculated as 321 days.

No fee is believed due. However, if any fee is due, please charge it to Deposit Account No. 06-1050, referencing Attorney Docket Number 19672-0003US1.

Respectfully submitted,

Date: October 24, 2011

/RSMcQuade/

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